

Application no. 09/516,849  
Amdt. dated March 15, 2004  
Reply to Office Action of December 15, 2003

## REMARKS / ARGUMENT

### A. INTRODUCTION

In the office action dated December 15, 2004, pending claims 1-37 were rejected: claims 1, 6-14, 18-23, 27-28, 33 were rejected under 35 U.S.C. § 102(e) in view of U.S. patent no. 6,084,879 to Berl *et al.* (hereafter "Berl"); and claims 2-5, 15-17, 24-26, 29-32, 34-37 were rejected under 35 U.S.C. § 103(a) based on Berl further in view of U.S. patent no. 6,335,935 to Kadambi *et al.* (hereafter "Kadambi").

### B. REJECTION OF CLAIMS 1, 7, 18 UNDER 35 U.S.C. § 102

Applicant submits that claims 1, 6-14, 18-23 of the present application are patently distinguishable with respect to Berl because Berl fails to disclose one or more limitations taught and claimed in the several embodiments of the present invention. Claim 1 of the present application recites, in relevant part:

"generating respective second priorities as a function of the respective first priorities"

Clearly, the priority of an outbound packet is generated based on the inbound priority to prevent the inbound priority, if enforced by the switch, would adversely affect the quality of service provided to traffic within the switch or affect traffic in other parts of the network, for example.

In contrast to the present invention, Berl discloses a switching node 650 that receives an inbound packet, tests whether the FID of the inbound packet matches a store FID (FIG. 10, step 1025), and tests whether the LFSID of the inbound packet matches a stored LFSID (step 1040). If the FID and LFSID are matched, the switching node assigns a type of service (TOS) to the outbound packet and then queues the packet for output based on a transmission priority (TP) level derived from the priority identifier (col. 11, line 62-col. 12, line 2). The priority identifier used by the switching node is transmitted to the switching node in the form of a

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packet-recognizing filter from hybrid node (col. 6, lines 32-39). Upon receipt of the filer, the switching node stores the priority identifier for purposes of inspecting and identifying inbound packets (col. 7, 11-14).

In view of the explanation above, it is clear that Berl is distinguishable from the present invention for two reasons. First, the outbound priority and output classification in Berl are wholly independent of the inbound priority. In fact, Applicant fails to see evidence that the switching node reads the inbound priority or performs classification of any type on the inbound priority. Since Berl does not selectively choose the outbound priority from inbound priority, the switching node in Berl is unable to selectively re-map the outbound priority where necessary to perform traffic engineering.

Second, the outbound priority assigned by Berl is fixed for each combination of FID and LFSID, i.e. it does not vary as a function of any criterion related to the inbound priority. In contrast to Berl, the outbound priority of a packet in the present invention can assume any of a range of values determined by the number of bits of the priority field of the outbound packet. An 802.1Q tag, for example, includes 3 bits that support an outbound priority between 0 and 7.

In the office action of December 15, page 3, lines 3-4, Examiner has indicated that that the first priorities, from which the second priorities are generated, are the format identifier (FID) and local form session identifier (LFSID) for identifying a session context. Being identifiers, these filed do not include a priority value and their values do not depend on any priority value of the inbound packet. Instead, the identifiers are transmitted from a hybrid node in the form of a filter (FIGS. 9A and 9B) that enables the switching node to recognize a session context where applicable (col. 6, lines 60-65). The fact that the FID and LFSID identifiers have an indirect and ancillary effect on the outbound packet priority does not teach or suggest the present invention in which the outbound priority is directly dependent on the inbound priority. Accordingly, when one considers the present invention as a whole, the FID and LFSID identifiers, taken collectively or separately, cannot be reasonably construed to be a marker according to the present invention.

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For the reasons stated above, Berl fails to anticipate the present invention in the embodiment of claim 1 and each of the following independent claims for the same reasons as claim 1:

Claim 7 ("determining a first priority for the packet based on the included priority"), and

Claim 18 ("determining a first priority for the packet based on the included priority").

#### C. REJECTION OF CLAIM 27 UNDER 35 U.S.C. § 102

Applicant submits that claim 27 of the present application is patently distinguishable with respect to Berl because Berl fails to disclose one or more limitations taught and claimed in the present invention as claimed in claim 27. Claim 27 recites, in relevant part:

"generating a first priority as a function of the tagged priority" received on a first port,

and

"identifying a second priority based on a second value associated with the packet"

and

"determining whether to apply the first priority or the second priority..."

In addition to the reasons stated above regarding the dependence of the first priority on the tagged priority, the present invention is not anticipated by Berl because Berl fails to disclose each of the steps of "generating a first priority," "identifying a second priority based on a second value associated with the packet," and "determining whether to apply the first priority or the second priority."

In contrast to the present invention, Berl attempts to identify the session context and either: (1) encapsulates the packet with the priority identifier if the packet is matched using the FID and LFSID, or (2) encapsulates the packet with the default priority if the packet is not matched. Since Berl uses either the priority identifier or default depending on the match test,

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Berl executes the step of “generating a first priority” or “identifying a second priority,” but not both. Thus, Berl fails to teach the steps of this embodiment of the present invention.

#### D. REJECTION OF CLAIMS 28, 33 UNDER 35 U.S.C. § 102

Applicant submits that claims 28 and 33 claims are not anticipated by Berl because Berl fails to disclose one or more limitations taught and claimed in the several embodiments of the present invention as claimed in claims 28 and 33. In particular, Berl also fails to anticipate claims 28 and 33 because each of these claims includes the step of:

“appending a priority select indicator comprising one or more bits to the plurality of packets”

This “priority select indicator,” when appended to a packet, may be used to incorporate a mark into a packet for purposes of instructing a downstream node as to which of a plurality of priority values is to be used to classify the packet. The Applicant respectfully submits that this limitation is neither taught nor suggested in the prior art.

In contrast to the present invention, Examiner states that the “priority select indicator” is equivalent to the “TP level tag” in Berl (office action, page 5, line 20). Examiner’s argument, however, does not hold together since a priority and the marker used to signal whether to use the priority and priority select indicator, i.e., the priority, cannot be the same field. If the marker is to have any meaning at all, it must be a separate field from the priority to which it pertains. If this is not self-evident, Applicant implores Examiner to call the undersigned in or to clarify this point.

In addition to the reasons stated above, Berl fails to teach the process of re-mapping an inbound priority using to create another priority:

claim 28 (“determining a first priority based on the included priority”) and  
style="padding-left: 40px;">claim 33 (“generating a second priority associated with each of the one or more packets as a function of the respective first priority”).

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#### E. REJECTION OF CLAIMS 7-14, 18, 19-23 UNDER 35 U.S.C. § 102

Claim 7 and 19 are not anticipated by Berl because Berl fails to disclose a process for marking a packet, e.g., with a “priority select indicator,” that is used to signal to another processor which of a plurality of priorities, e.g. first priority and second priority, to use for processing. The marking must necessarily be a separate value than either of the two priorities.

In support of the rejection, it appears that Examiner has taken the position that a packet is “marked” if the FID and LFSID of the packet match an FID and LFSID stored in memory. Applicant respectfully submits that Examiner’s attempt to equate the session-context identifiers used by Berl with the priority selection marking of the present invention mischaracterizes the prior art. A marking is a special-purpose control field used to signal a node which priority to use. In contrast, the FID/LFSID identifiers are indirectly linked to the output priority to the extent that the session context is either recognized or not. Consider the invention as a whole, it not reasonably to construe the FID and LFSID identifiers to be a marker according to the present invention.

#### F. REJECTION OF CLAIMS 2-3 UNDER 35 U.S.C. § 103

Dependent claims 2-3 depend from independent claim 1, which is patently distinguishable from the prior art. In addition, the prior art cited teaches away from the present invention, there is no motivation to combine, and it appears impermissible hindsight has been used in support of the obviousness rejection.

Claim 2 recites, in relevant part, that: “ones of packets prioritized as a function of respective ones of the second priorities are selected as a function of respective ones of the source addresses.” Claim 3 recites, in relevant part, that: “ones of packets not prioritized as a function of respective ones of the second priorities are prioritized as a function of respective ones of the destination addresses.”

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(1) References Teach Away

Applicant submits that claims 2-3 of the present application are patentably distinguishable with respect to Berl and Kadambi because Berl teaches away from the present invention. In particular, Berl teaches that the priorities applied to outbound packets at a switching node in a heterogeneous network are not determined from the packets themselves, but are compiled from the packet recognition filters received from hybrid nodes within the network. Berl specifically states that the "The mechanism [for conveying information pertaining to transmission priority (TP) levels of inbound packets] comprises a packet-recognizing filter having a novel format that is generated by the hybrid node and dynamically transmitted to the switching node over a predefined communication channel of the network" (col. 6, lines 29-36). Berl, therefore, teaches away from inspecting the inbound packets for the source address to select the inbound packets that are to have their respective priority replaced, as is claimed in claim 1. Similarly, Berl teaches away from inspecting the inbound packet for the destination address to classify packets whose inbound priority was not replaced with a second priority.

(2) No Motivation to Combine

In addition, Applicant respectfully asserts that Examiner has failed to state a *prima facie* case of obviousness because the "motivation" to combine is vague and lacking the requisite specificity. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (Patent Office must "identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them"). In the office action, Examiner has merely stated that it would have been obvious to one skilled in the art to combine Berl and Kadambi because:

"...a person of ordinary skill in the art would have readily recognized the desirability and advantage of modifying the system to employ the feature shown by Kadambi in order to use standard Class of Service for table filtering of untagged packets..." (office action, page 7, lines 6-8).

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This statement regarding "...readily recognized the desirability and advantage of modifying the system to employ the feature shown by Kadambi..." fails to include any foundation in the prior art and fails to state any reasoning by which a practitioner would deduce the claimed invention. Moreover, Examiner's statement fails to specify the meaning of "desirability and advantage," fails to identify the "feature of Kadambi," and fails to establish a convincing line of reasoning establishing how one skilled in the art would have "readily recognized" that desirability and advantage.

Applicant respectfully asserts that Examiner's reference to a "desirability and advantage" is insufficient to suggest to one skilled in the art to combine the references cited by Examiner. In particular, the motivation to combine offered by Examiner is too vague to demonstrate that the prior art suggests one skilled in the art combine Berl with Kadambi, or a convincing line or reasoning that would have lead one to combine Berl and Kadambi as claimed in the present invention. ATD Corporation v. Lydall, Inc., 48 USPQ 2d 1321, 1329 (Fed. Cir. 1998) (Determination of obviousness requires a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor).

### (3) Impermissible Hindsight

In the absence of a convincing line of reasoning establishing a motivation to combine, it would appear that the deficiencies of the prior art and the "desirability and advantage" of the solution provided by the present application were derived from the present application itself. Regrettably, Applicant has no alternative but to presume that Examiner has relied on impermissible hindsight in order to arrive at a combination of references that allegedly solves the same problem as the present invention. Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 45 USPQ 2d 1977, 1981–82 (Fed. Cir. 1998) (defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness).

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**G. REJECTION OF CLAIMS 4-5, 15-17, 24-26, 29-32, 34-37 UNDER 35 U.S.C. § 103**

Applicant respectfully asserts that claims 4-5, 15-17, 24-26, 29-32, 34-37 because a prima facie case of obviousness is absent from the office action. In particular, the office action of December 14 fails to state a motivation to combine Berl and Kadambi for each of these claims. Although Applicant has noted the stated motivation to combine recited on page 7, lines 6-8, this asserted motivation appears to pertain to claims 2-3 specifically. Instead of specific motivation to combine under claims 4-5, 15-17, 24-26, 29-32, 34-37, Examiner has merely cited where in the prior art various limitations are shown:

- Claim 4, 5, 6 ("...Kadambi shows the first and second priorities..."),
- Claim 15, 24, 34 ("...Kadambi shows first value..."),
- Claim 16, 17, 25, 26, 35 ("...Kadambi shows second value..."),
- Claim 29, 37 ("...Kadambi shows 802.1p priorities..."),
- Claim 30 ("...Kadambi shows the first and second priorities..."),
- Claim 31 ("...Berl shows the tag..."),
- Claim 32 ("...Berl shows second priority...").

Without a proper motivation to combine, Applicant respectfully suggests that Examiner has merely documented that the various individual elements of the present invention are known in the prior, not that the invention is obviousness. Ex parte Clapp, 227 USPQ 972, 973 (B.P.A.I. 1985) (Board reversed rejection because examiner merely cited references to show elements or subcombinations without establishing that the references expressly or impliedly suggested, and without a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references). Applicant's invention, which pertains to the claimed combination of these elements and not the individual elements themselves, is therefore allowable.

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## H. CONCLUSION

Claims 28 and 33 have been re-formatted in order to better present the claims for examination. The change in format is unrelated to the prior art and is not done for reasons related to patentability.

## I. CONCLUSION

For all the forgoing reasons, Applicant submits that the present invention is patently distinguishable from the prior art and respectfully requests that a timely Notice of Allowance be issued in this case.

Should there be any fees for this action, your office is authorized to draw from the firm deposit account number 02-3979. Should you have any questions, or identify any problem, the undersigned would appreciate a telephone call so that this matter may be resolved promptly.

Respectfully submitted,

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